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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,569	12/10/2001	Kazuo Iwai	1422-0508P	3472

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EXAMINER

OLSZEWSKI, JOAN M

ART UNIT PAPER NUMBER

3643

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,569

Applicant(s)

IWAI, KAZUO

Examiner

Joan M. Olszewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

FINAL REJECTION

This is in response to Applicant's amendments filed January 22, 2004 and February 10, 2004. Currently, claims 11-22 and 24-27 are pending in this application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-22 and 24-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 11-14 of copending Application No. 10/291,473 in view of JP 07135896 A.

The above identified claims of pending applicant's 10/291,473 set forth all of the method steps claimed except for using the process to treat poultry. However, JP 07135896 A teaches that it is well known to use an hinokitiol solution to treat a wide variety of fish and animal meat. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method as set forth in the above identified claims of the application by using the process to treat

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poultry as taught by JP 07135896 A since it is routinely known to use the same type of solution to treat a wide range of edible food stuffs.

This is a provisional obviousness-type double patenting rejection.

Claims 11-22 and 24-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3,4,6-9, and 14-16 of U.S. Patent No. 6,554,620 in view of Kurschner et al.(US Patent 5,632,676) in view of Nishimoto et al. (US Patent 6,165,964).

The above identified claims of US Patent 6,554,620 set forth all of the method steps claimed except for the treatment occurring during the processing of poultry or the specific PH and temperature. The Kurschner et al. reference teaches the sterilizing treatment of poultry during the processing of the meat at a temperature within the claimed range. The Nishimoto patent teaches the use of hinokitiol solution for sterilization purposes within the claimed PH range. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method as set forth in the above identified claims of the application by utilizing the sterilizing treatment of poultry during the processing of the meat at a temperature within the claimed range as taught by Kurschner et al. in order to provide sterilized poultry meat. Further, by substituting the antibacterial solution hinokitiol within the claimed PH range as taught by Nishimoto in order to ensure proper sterilization of the poultry meat during processing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurschner et al. (U.S. Patent 5,632,676) in view of Nishimoto et al. (U.S. Patent 6,165,964) and Takahashi (US Patent 6,352,727).

Regarding Claims 11, 12, 17, 18 and 25-27 Kurschner et al. disclose a method of sterilizing poultry meat (Abstract) comprising the step of subjecting the poultry meat to a contact treatment with a solution during the poultry processing for the production of poultry meat; wherein the contact treatment is carried out at least in one step in the poultry processing comprising plural treatment steps (column 2, lines 19-25)(Kurschner et al.) as well as in one interval between consecutive two steps in the treatment steps (column 3, lines 26-32)(Kurschner et al.); wherein the treatment step is selected from the group consisting of an evisceration step, a chilling step, and a wrapping step (column 1, lines 12-57)(Kurschner et al.); wherein the contact treatment occurs in the interval between the evisceration step and the chilling step (column 3, lines 26-32)(Kurschner et al.). Kurschner et al. do not teach the use of the contact treatment being a hinokitiol solution. However, Nishimoto et al. teach the use of an aqueous antibacterial solution of hinokitiol for disinfection purposes (Abstract) for use in food

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factories (column 9, lines 4-6). Further, Takahashi teaches that hinokitiol cannot only be used to treat meat processing equipment but can also be used to treat the meat itself (column 7, lines 30-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made by modifying the antibacterial solution of Kurschner et al. by substituting the antibacterial solution hinokitiol as taught by Nishimoto et al. to sterilize poultry meat during processing. Further, Takahashi teaches that the hinokitiol solution has a wide range of uses such as sterilizing utensils or sterilizing meat. As such this would only be the substituting of one well known sterilizing agent for another.

Re- Claims 13,14,19, 20 and 24, the combination of Kurschner et al. as modified by Nishimoto et al. and Takahashi discloses all the claimed features including wherein the concentration of hinokitiol in the solution is from 1-50000 ppm (column 8, lines 54-60)(Nishimoto et al.); and wherein the aqueous hinokitiol solution has a PH of 4 to 11 (column 11, lines 45-47)(Nishimoto et al.).

Re- Claims 15, 21 and 24, the combination of Kurschner et al. as modified by Nishimoto et al. and Takahashi discloses all the claimed features including wherein the contact treatment is carried out at a temperature of 0° to 70° C (column 3, lines 26-32)(Kurschner et al.).

Re- Claims 16 and 22, the combination of Kurschner et al. as modified by Nishimoto et al. Takahashi and discloses all the claimed features including wherein the contact treatment is accomplished by a method consisting of applying a coat (column 3,

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lines 42-48)(Kurschner et al.), or spraying (column 3, lines 26-27)(Kurschner et al.), or immersion (column 3, lines 28-29)(Kurschner et al.).

Response to Arguments

Applicant's arguments filed 1/22/04 and 2/10/04 have been fully considered but they are not persuasive.

Applicant argues that there is no teaching to combine the teachings of Kurschner et al. and Nishimoto et al. '964 since the Nishimoto et al. '964 device is directed to treat equipment used in a kitchen and does not disclose using the antimicrobial agent on food. Applicant also argues that the Examiner has failed to show any of the possible sources of motivation. However, the Examiner maintains that the combination is proper since both of the references deal with the same problem to be solved, that of sterilizing a product. Thus, while Nishimoto et al. '964 does not specifically state that a hinokitiol solution could be used to sterilize meat products one would look to other areas where sterilization is required to find solutions which might work better or be less costly to use. As to the issue that scientific evidence has not been presented by the Examiner to support the position that sterilization methods to disinfect medical equipment or factories are equivalent to sterilization methods to disinfect food the Examiner is in full agreement. However, this is not what the Examiner has done in the rejections. The Nishimoto et al. '964 device was only relied on to teach the use of a specific sterilization solution not to use the same procedure for kitchen equipment on meat products. Further, while Applicant has submitted two declarations neither of these set forth scientific evidence as to why one would not consider using hinokitiol solution for

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sterilizing meat products. Also, the instruments cleaned by the hinokitiol solution would be used to cut edible food stuffs and as such the hinokitiol solution must be safe for human consumption since residue of the solution would inherently be left on the food stuffs.

Applicant also argues that the addition of the Takahashi reference fails to supply what is missing in the combination of Kurschner et al. and Nishimoto et al. '964 since Takahashi does not teach that hinokitiol solution can treat both meat and meat processing equipment. However, column 6, lines 20-29 of Takahashi teaches that there can be a mix of bactericides to treat foods, and column 7, lines 4-8 of Takahashi indicates hinokitiol as one of the bactericides. Finally, column 7, lines 30-55 of Takahashi suggests how bactericides are mixed to be used on meats. As such the Takahashi reference is the link to show that various bactericides can be used on both equipment and meat and that hinokitiol is a well known bactericide included in this grouping.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joan M. Olszewski whose telephone number is 703-305-2693. The examiner can normally be reached on Monday-Friday (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 703-308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joan M. Olszewski
Patent Examiner
Art Unit 3643

JMO


PETER M. POON
SUPERVISORY PATENT EXAMINER

3/5/04